

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-16 are all the claims pending in the application. Applicant respectfully submits that the pending claims define patentable subject matter.

Claims 1-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasan et al. (WO/0131963; hereinafter “Hasan”) in view of Soininen et al. (U.S. Patent No. 10,482,047; hereinafter “Soininen”). Applicant respectfully traverses this rejection.

Independent claim 1 recites, in part:

determining whether a change of cell to a third generation cell is possible if a terminal already has one of a circuit connection and a packet connection already set up in a second generation cell and requests a simultaneous connection of the other one of the circuit connection and the packet connection[.]

Thus, claim 1 requires, *inter alia*, determining whether a change of cell to a third generation cell is possible if a terminal already has one of a circuit connection and a packet connection already set up in a second generation cell and requests a simultaneous connection of the other one of the circuit connection and the packet connection. That is, the terminal requests a simultaneous connection of the other one of the circuit connection and the packet connection.

Hasan discloses a method of handing over a mobile terminal from a second generation switching center to a service node in an IP-based third generation network.¹ Hasan, however, fails to teach or suggest if a terminal already has one of a circuit connection and a packet

¹ See Hasan, Abstract.

connection already set up in a second generation cell, the terminal requests a simultaneous connection of the other one of the circuit connection and the packet connection.

Instead, under Hasan, a terminal requests for a type of service not offered by the second generation circuit-switched network, and based upon that request, as well as the availability of a third generation network, Hasan effects a handover from the second generation network circuit-switched network to the third generation IP-based network.² Hasan does not, however, contemplate a terminal, having either a circuit or a packet connection in a second generation network, requesting a simultaneous connection of the other type of connection, i.e., a circuit or a packet connection, in a third generation cell.

Nonetheless, the Examiner asserts that Hasan teaches this unique claimed feature, and cites page 2, line 28 to page 3, line 5 of Hasan in support of her position. However, the cited portion only states that a handover is made from the second generation network circuit-switched network to the third generation IP-based network, if the request is made by the terminal to use a third generation network feature. Hasan fails to teach or suggest that the requested packet service is requested as a simultaneous connection to the existing connection in the second generation network (i.e., circuit or packet). Indeed, Hasan is completely silent with respect to any sort of request initiated by the terminal that involves simultaneous connections, as claim 1 requires. Therefore, Applicant submits that Hasan fails to teach or suggest all of the required features of claim 1.

² See Hasan, Abstract.

Further, Soininen fails to supply the above-noted feature missing from Hasan. Soininen discloses establishing simultaneous circuit and packet connections strictly within a third generation cell.³ In other words, like Hasan, Soininen fails to teach or suggest a terminal, having either a circuit or a packet connection in a second generation network, requesting a simultaneous connection of the other type of connection, i.e., a circuit or a packet connection, in a third generation cell. Thus, neither of the cited references, alone or in combination, teach or suggest all of the above-noted features of claim 1.

Claim 1 further recites, in part:

performing said change of cell in order to allow said simultaneous connection of the circuit and packet connections in the third generation cell.

Thus, claim 1 requires, *inter alia*, that the change of cell be performed in order to allow the simultaneous connection of the circuit and packet connections in the third generation cell.

The Examiner asserts that Hasan teaches the “performing said change of cell in order to allow packet connections.” The Examiner concedes, however, that Hasan fails to teach or suggest allowing simultaneous circuit and packet connections in a third generation cell. Instead, the Examiner contends that Soininen discloses this feature. Applicant respectfully submits the rejection is improper.

As noted above, claim 1 requires, *inter alia*, that the change of cell be performed in order to allow the simultaneous connection of the circuit and packet connections in the third generation

³ See Soininen, Abstract and paragraph [0024].

cell. In other words, the change of cell is performed in order to allow the simultaneous connections. Thus, even assuming, *arguendo*, that Hasan discloses performing a change of cell in order to allow packet connections, and Soininen discloses simultaneous connections, neither reference teaches or suggests performing a change of cell in order to allow the simultaneous connections, as claim 1 sets forth.

The Examiner further argues that one of ordinary skill in the art at the time the invention was made, it would have been obvious to modify Hasan in view of Soininen “to include allowing said circuit and packet connections simultaneously in a third generation cell,” and that the motivation for this modification would have been to “provide a coherent user experience.”⁴ Applicant respectfully disagrees with the Examiner’s position.

First, Applicant submits that Soininen contains no suggestion or teaching whatsoever that would motivate one of ordinary skill in the art at the time the invention was made to modify Hasan to include the simultaneous connections of Soininen. As pointed out above, Soininen only discloses establishing simultaneous circuit and packet connections within a third generation cell. Since Soininen does not apply to second generation networks, there can be no motivation to modify Hasan to include the simultaneous third generation network connections of Soininen.

Second, any such modification of Hasan in view of Soininen would not yield the all of the claimed features of the present invention. As noted above, claim 1 requires, *inter alia*, the terminal requests the simultaneous connection (i.e., of the circuit connection or the packet connection). Neither reference teaches or suggests this unique feature of claim 1.

⁴ See Office Action, page 4, lines 7-10.

Accordingly, Applicant submits that claim 1 is patentable over the applied references, for at least the reasons stated above. Furthermore, since independent claims 12-14 recite features similar to claim 1, Applicant submits that independent claims 12-14 are patentable over the applied references for reasons analogous to those stated above with regard to claim 1. Finally, Applicant submits that dependent claims 2-11, 15 and 16 are patentable over the applied references, at least by virtue of their respective dependency on claims 1 and 12.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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